

### **Remarks**

Claims 1-44, 56-61, 64-67, 69-76, 81-96, 101-103, 106-110 and 112-120 were previously pending, of which claims 64-65, 74, and 101-103 have been presently amended, claims 72-73 have been presently cancelled and claims 121 and 122 have been added. Thus, claims 1-44, 56-61, 64-67, 69-71, 75, 76, 81-96, 101-103, 106-110 and 112-122 are currently pending. Applicant notes with appreciation the allowance of claims 1-44, 56-61, 66-67, 69-71, 75, 76, 81-96, 106-110, and 112-119.

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

### **Rejections under 35 U.S.C. § 102**

Claim 74 stands rejected under 35 U.S.C. §102(b) as being anticipated by Yakish (U.S. Patent No. 3,864,758). This rejection is respectfully traversed.

As stated previously, MPEP § 2131 requires that to sustain a rejection of claim 74, the Yakish patent must teach or suggest each element of the claim. Applicant respectfully submits that in light of the amendment to claim 74, the Yakish patent does not teach or suggest each element of the claim. Claim 74 recites:

A bone joint implant comprising at least two opposing shells, a central body disposed between the two opposing shells, and at least one sealable opening for the introduction of a lubricant into the implant after the implant has been assembled.

The Yakish patent fails to teach the use of “at least one sealable opening for the introduction of a lubricant into the implant after the implant has been assembled.” Instead, the Yakish patent teaches a design “with internal cavity 7, fully filled with permanently hermetically inclosed lubricating fluid ....” (col. 1, lines 44-46, sic).

Therefore, the rejection of claim 74 is not supported by the Yakish patent and should be withdrawn.

**Rejections under 35 U.S.C. §103**

Claims 64-65 stand rejected over the combination of Büttner-Janz et al. (U.S. Patent No. 5,401,269) and Walker (U.S. Patent No. 4,193,139) Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claims 64-65.

It is submitted that, in the present case, the Office Action cannot factually support a prima facie case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Büttner-Janz and Walker patents cannot be applied to reject claim 64 under 35 U.S.C. § 103 which provides:

*A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. (Emphasis added)*

Claim 64 provides:

A bone joint implant comprising a central body positioned between two shells, wherein each shell has a relatively smooth inner surface that contacts the central body and at least one shell has a centralized motion constraint protuberance.

Thus, as provided in MPEP § 2143, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither of the cited references teaches or suggests a shell having “a relatively smooth inner surface that contacts the central body and at least one shell has a centralized motion constraint protuberance,” as is claimed in claim 64.

Therefore, it is impossible to render the subject matter of claim 64 as a whole obvious in light of the cited references because the explicit terms of the statute cannot be met. For this reason alone, the rejection of claim 64 under 35 U.S.C. § 103 should be withdrawn. Claim 65 depends from and further limits claim 64 and should also be allowed.

**Claims 72-73**

These claims have been cancelled.

**Claims 101-103**

Claims 101-103 stand rejected over the combination of Bryan et al. (U.S. Patent No. 5,674,296) and Buechel et al. (U.S. Patent No. 5,868,796). In light of the amendments, Applicant respectfully submits that the cited references do not support prima facie case of obviousness as to claims 101-103 and should be withdrawn for the following independent reasons

Claim 101 provides:

A motion-preserving bone joint implant comprising a central body having a resilient, deformable portion and a coating thereon wherein the resilient, deformable portion allows motion in the joint implant and the coating material has a different hardness from the resilient, deformable portion.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

As provided in MPEP § 2143, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither of the cited references teaches or suggests a “a central body having a resilient, deformable portion and a coating thereon wherein ... the coating material has a different hardness from the resilient, deformable portion,” as is claimed in claims 101-102. The Bryan patent teaches a resilient body 20 with additional stiffness provided by gasket 22. The Buechel patent teaches a coating 26 applied to the end 17 of a *titanium alloy* substrate 20 (col. 6 lines 44-46, emphasis added). The Buechel patent does not teach or suggest putting a coating on a resilient, deformable portion as is presently claimed.

Therefore, the Examiner has not shown a coating on a resilient, deformable portion. It is therefore impossible to render the subject matter of claims 101-103 as a whole obvious in light of the cited references. For this reason alone, the rejection of claims 101 - 103 under 35 U.S.C. § 103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

As discussed above, the Buechel patent teaches a method of depositing a coating 26 on a metal alloy substrate 20 to promote wear resistance and lubricity (col. 8, lines 24-28). There is no discussion or motivation by the Buechel patent to use a resilient, deformable substrate instead of the metal alloy substrate. In fact, the teaching of a metal alloy substrate 20 is opposite to the teaching of the present application.

Since it is well recognized that teaching away from the claimed invention is a per se demonstration of lack of prima facie obviousness, it is clear that the Examiner has not borne the initial burden of factually supporting any prima facie conclusion of obviousness.

Thus, for this reason alone, the rejection of claims 101 and 103 under 35 U.S.C. § 103 should be withdrawn.

3. The Combination of References is Improper

As stated before, contrary to the requirements of MPEP §2143.01 and court holdings as set forth previously, it is clear that in the present case, the combination arises solely from impermissible hindsight based on the invention itself without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 101 and 103.

Therefore, with regard to claims 101-103 as herein amendment, the Examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection of claim 101 and 103 under 35 U.S.C. § 103 should be withdrawn.

**Conclusion**

As a result of the foregoing, it is respectfully asserted that pending claims 1-44, 56-61, 64-67, 69-71, 75, 76, 81-96, 101-103, 106-110 and 112-122 are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to contact the undersigned at the below listed

telephone number. Also, Deposit Account No. 08-1394 may be used for any over or under payments.

Respectfully submitted,

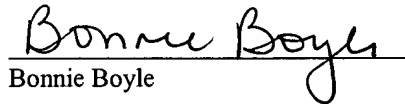


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